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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/842,655	04/27/2001	Haruhiko Kinoshita	048369/0122	7697
22428	7590	03/07/2006	EXAMINER	
FOLEY AND LARDNER LLP			THAI, CANG G	
SUITE 500			ART UNIT	PAPER NUMBER
3000 K STREET NW			3629	
WASHINGTON, DC 20007			DATE MAILED: 03/07/2006	

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/842,655	KINOSHITA, HARUHIKO
	Examiner	Art Unit
	Cang G. Thai	3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 08 November 2005.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 10-24 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 10-24 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892) 4)  Interview Summary (PTO-413)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948) Paper No(s)/Mail Date. \_\_\_\_\_  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_ 5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_

## DETAILED ACTION

### ***Response to Amendment***

This is in response to an amendment filed on 11/08/2005 for letter for patent filed on 04/27/2001. Claims 1-9 are cancelled. Claims 10-24 are pending in this letter.

### ***Status of Claims***

#### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 10-24 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 5,864,871 (KITAIN ET AL).

As for claim 10, KITAIN discloses a system, comprising:

an application service provider server, said application service provider server including a storage device {Column 12, Lines 35-36, wherein this reads over "The repository server 2 comprises or is coupled to at least two database servers 11, 13"}; a candidate enterprise terminal, said candidate enterprise terminal connected to said application service provider server by a communication network, said candidate enterprise terminal being configured to transmit at least non-public business information to said application service provider server, said non-public business information including at least non-public financial, accounting, and tax information of a candidate enterprise, said application service provider server being configured to store said non-

public business information in said storage device {Column 10, Lines 34-36, wherein this reads over "the information received from the contributor workstations are files comprising one or more documents"}; and

a merger and acquisition brokering business entity terminal, said merger and acquisition brokering business entity terminal connected to said application service provider server by said communication network, said merger and acquisition brokering business entity terminal being configured to obtain said non-public business information from said application service provider server, said merger and acquisition brokering business entity terminal being further configured to generate a merger or acquisition proposal based on said non-public business information, said merger or acquisition proposal being a proposal that specifies terms for a merger or an acquisition related to said candidate enterprise {Column 4, Lines 2-9, wherein this reads over "portfolio managers, investment brokers and traders could also access, at a single site, using a single integrated system, the wide array of information that is produced by the subject corporations themselves, such as, for example, annual reports, as well as profiles designed to highlight those features of a corporation and its strategy that are of particular relevance to investors"}.

As for claim 11, KITAIN discloses the system of claim 10, further comprising:

a second candidate enterprise terminal, said second candidate enterprise terminal connected to said application service provider server by said communication network, said second candidate enterprise terminal being configured to transmit at least second non-public business information to said application service provider server, said

second non-public business information including at least non-public financial, accounting, and tax information of a second candidate enterprise, said application service provider server being configured to store said second non-public business information in said storage device {Column 4, Lines 2-9, wherein this reads over "portfolio managers, investment brokers and traders could also access, at a single site, using a single integrated system, the wide array of information that is produced by the subject corporations themselves, such as, for example, annual reports, as well as profiles designed to highlight those features of a corporation and its strategy that are of particular relevance to investors"};

wherein said merger and acquisition brokering business entity terminal is further configured to obtain said second non-public business information from said application service provider server {Column 17, Lines 14-16, wherein this reads over "The repository server 2 constantly maintains an up to date list of all the report groups available along with the reports in the relational database 11"}; and

wherein said merger and acquisition brokering business entity terminal is further configured to generate said merger or acquisition proposal based on said non-public business information and based on said second non-public business information, said merger or acquisition proposal being a particular proposal that specifies terms for a particular merger or a particular acquisition between said candidate enterprise and said second candidate enterprise {Column 4, Lines 2-9, wherein this reads over "portfolio managers, investment brokers and traders could also access, at a single site, using a single integrated system, the wide array of information that is produced by the subject

corporations themselves, such as, for example, annual reports, as well as profiles designed to highlight those features of a corporation and its strategy that are of particular relevance to investors"}.

As for claim 12, KITAIN discloses the system of claim 10, wherein said candidate enterprise terminal is configured to transmit updated non-public business information to said application service provider server at specified times {Column 17, Lines 18-20, wherein this reads over "The list is also updated after a contributor changes the entitlement status of an individual investor (or investor group)"}.

As for claim 13, KITAIN discloses the system of claim 10, wherein said communication network is the Internet {Column 1, Lines 39-41, wherein this reads over "Global computer networks, such as the Internet, enable information to be distributed to a wide range of people at locations around the world"}.

As for claim 14, KITAIN discloses the system of claim 10, wherein said application service provider server comprises a computer {See Fig. 1, Element 1};

wherein said candidate enterprise terminal comprises a computer {See Fig. 1, Element 8}; and

wherein said merger and acquisition brokering business entity terminal comprises a computer {See Fig. 1, Element 4}.

As for claim 15, KITAIN discloses the system of claim 10,

wherein said non-public business information has not been made public {Column 8, Lines 60-61, wherein this reads over "a user of an electronic research delivery system will have more complete information than current available"}.

As for claim 16, KITAIN discloses a method, comprising:

sending at least non-public business information from a candidate enterprise terminal to an application service provider server over a communication network, said non-public business information including at least non-public financial, accounting, and tax information of a candidate enterprise {See Fig. 1, Element 6};

storing, by said application service provider server, said non-public business information {See Fig. 1, Element 2};

sending said non-public business information from said application service provider server to a merger and acquisition brokering business entity terminal over said communication network in response to a request from said merger and acquisition brokering business entity terminal {See Fig. 2, Element 212}; and.

generating, by said merger and acquisition brokering business entity terminal, a merger or acquisition proposal based on said non-public business information, said merger or acquisition proposal being a proposal that specifies terms for a merger or an acquisition related to said candidate enterprise {See Fig. 4, Element 106}.

As for claim 17, KITAIN discloses the method of claim 16, further comprising:

sending said merger or acquisition proposal from said merger and acquisition brokering business entity terminal to said candidate enterprise terminal {See Fig. 5, Element 34}.

As for claim 18, KITAIN discloses the method of claim 16, further comprising:

sending at least second non-public business information from a second candidate enterprise terminal to said application service provider server over said communication network, said second non-public business information including at least non-public financial, accounting, and tax information of a second candidate enterprise {See Fig. 5, Element 8};

storing, by said application service provider server, said second non-public business information {See Fig. 5, Element 13};

sending said second non-public business information from said application service provider server to said merger and acquisition brokering business entity terminal over said communication network in response to a second request from said merger and acquisition brokering business entity terminal {See Fig. 5, Element 8}; and

generating, by said merger and acquisition brokering business entity terminal, a second merger or acquisition proposal based on said second non-public business information, said second merger or acquisition proposal being a second proposal that specifies terms for a second merger or a second acquisition related to said second candidate enterprise {See Fig. 5, Element 34}.

As for claim 19, KITAIN discloses the method of claim 16, wherein said step of sending at least non-public business information from a candidate enterprise terminal to an application service provider server over a communication network, comprises:

periodically sending non-public business information from a candidate enterprise terminal to an application service provider server over a communication network, said

non-public business information including at least non-public financial, accounting, and tax information of a candidate enterprise {See Fig. 6A, Element 654}.

As for claim 20, KITAIN discloses the method of claim 16,  
wherein said communication network is the Internet {See Fig. 5, Element 4}.

As for claim 21, KITAIN discloses the method of claim 16,  
wherein said application service provider server comprises a computer {See Fig. 5, Element 13};  
wherein said candidate enterprise terminal comprises a computer {See Fig. 5, Element 8}; and

wherein said merger and acquisition brokering business entity terminal  
comprises a computer {See Fig. 5, Element 34}.

As for claim 22, KITAIN discloses the method of claim 16,  
wherein said non-public business information has not been made public {Column 8, Lines 60-61, wherein this reads over "a user of an electronic research delivery system will have more complete information than current available"}.

As for claim 23, KITAIN discloses a storage medium storing a program for  
causing a merger and acquisition brokering business entity computer to execute a  
process, said process comprising:

sending a request for non-public business information to an application service  
provider server over a communication network {Column 10, Lines 34-36, wherein this  
reads over "the information received from the contributor workstations are files  
comprising one or more documents"};

receiving said non-public business information from said application service provider server that is transmitted over said communication network in response to said request {Column 10, Lines 34-36, wherein this reads over "the information received from the contributor workstations are files comprising one or more documents"}, said non-public business information including at least non-public financial, accounting, and tax information of a candidate enterprise, said non-public business information having been provided to said application service provider server by a candidate enterprise terminal {Column 8, Lines 60-61, wherein this reads over "a user of an electronic research delivery system will have more complete information than current available"}; and

generating a merger or acquisition proposal based on said non-public business information, said merger or acquisition proposal being a proposal that specifies terms for a merger or an acquisition related to said candidate enterprise {Column 4, Lines 20-28, wherein this reads over "Research distribution systems include research reports but not corporate web sites or annual reports, the EDGAR database includes 10-K and 10-Q filings but not brokerage firms research reports or corporate web sites, Internet search engines search web sites and some public databases but not brokerage firms research reports or most corporation's annual reports"}.

As for claim 24, KITAIN discloses the storage medium of claim 23, said process further comprising:

sending a second request for non-public business information to said application service provider server over said communication network {Column 10, Lines 34-36,

wherein this reads over "the information received from the contributor workstations are files comprising one or more documents"};

receiving said second non-public business information from said application service provider server that is transmitted over said communication network in response to said second request, said second non-public business information including at least non-public financial, accounting, and tax information of a second candidate enterprise, said non-public business information having been provided to said application service provider server by a second candidate enterprise terminal {Column 13, Lines 31-33, wherein this reads over "The response can be HTML files, GIF files, PDF files or any data that the Internet browser can view"}; and

generating a second merger or acquisition proposal based on said second non-public business information, said second merger or acquisition proposal being a second proposal that specifies terms for a second merger or a second acquisition related to said second candidate enterprise {Column 4, Lines 20-28, wherein this reads over "Research distribution systems include research reports but not corporate web sites or annual reports, the EDGAR database includes 10-K and 10-Q filings but not brokerage firms research reports or corporate web sites, Internet search engines search web sites and some public databases but not brokerage firms research reports or most corporation's annual reports"}.

### ***Conclusion***

3. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

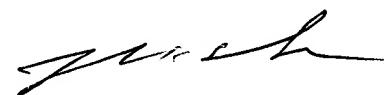
No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cang (James) G. Thai whose telephone number is (571) 272-6499. The examiner can normally be reached on 6:30 AM - 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CGT  
03/01/2006



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